

#8

#8

Patent
Attorney's Docket No. 016800-457

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

TECH CENTER 1600/2900

FEB 13 2002

RECEIVED

In re Patent Application of)
)
Didier CANDAU) Group Art Unit: 1616
)
Application No.: 09/927,488) Examiner: Marina Lamm
)
Filed: August 13, 2001)
)
For: PHOTOPROTECTING/COSMETIC)
COMPOSITIONS COMPRISING)
BENZOTRIAZOLE AND BIS-)
RESORCINYLTRIAZINE)
)

**PETITION TO RESET A PERIOD FOR REPLY DUE TO
LATE RECEIPT OF AN OFFICE ACTION UNDER 37 CFR 1.181(a)(3)**

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Applicant hereby respectfully petitions the United States Patent and Trademark Office ("Office") to restart the previously-set period for reply to the Communication scheduled to be mailed December 10, 2001, in the instant application.

FACTS

1. On January 25, 2002, Applicant's counsel received an Office communication ("Communication") listing December 10, 2001, as its "Date Mailed." See Exhibit 1, Cover Sheet, attached.

2. The Communication was stamped with the January 25, 2002, date of receipt at the office of the undersigned. *See* Exhibit 1, Cover Sheet, attached. The small January 24, 2002, stamp is the result of Applicant's counsel's records department failing to advance its manual stamp. The large "Docketed" stamp correctly reflects the date of receipt in Applicant's counsel's office.

3. The Communication is a Restriction Requirement which set forth a shortened statutory period for reply of one month. *See* Exhibit 1, Office Action Summary, attached. Accordingly, the period for reply expired on January 10, 2002 — one month from the alleged mailing date of December 10, 2001.

4. As of the date of filing this Petition with the Office, less than two weeks has elapsed since receiving the Communication.

5. A substantial portion of the reply period, *i.e.*, *all* of the period, had elapsed by the time the Communication was received.

REMARKS

Section 710.06 of the Manual of Patent Examining Procedure states that the Office *will* grant a petition to restart the previously set period for reply to an Office action to run from the date of receipt of the Office action at the correspondence address if the following three criteria are met: (1) the petition is filed within two weeks of the date of receipt of the Office action at the correspondence address; (2) a substantial portion of the set reply period had elapsed on the date of receipt of the Office action; and (3) the petition includes

Applicant believes that he has satisfied the requirements of Section 710.06, and therefore respectfully petitions that the period for reply to the Communication be reset to run from January 25, 2002.

Applicant maintains that the Communication, despite its listed December 10, 2001, mailing date and postmark (*See Exhibit 2, attached*), did not arrive at the correspondence address until January 25, 2002. Applicant believes that the Communication may have been intercepted by the United States Postal Service and irradiated in light of the anthrax situation. Applicant believes that this process resulted in the delay between the mailing of the Communication from the Office and its receipt at the correspondence address.

CONCLUSION

In light of the foregoing, Applicant respectfully petitions that the period for reply to the Communication be reset to run from January 25, 2002 — the date of receipt of the Communication.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

By: 

Erin M. Dunston

Provisional Registration No. P-51,147

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620

Date: February 8, 2002

EXHIBIT 1

Office Communication



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/927,488 | 08/13/2001 | Didier Candau | 016800-457 | 5299 |

7590

12/10/2001

Norman H. Stepno, Esquire
BURNS, DOANE, SWECKER & MATHIS, L.L.P.
P.O. Box 1404
Alexandria, VA 22313-1404

EXAMINER

LAMM, MARINA

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 12/10/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

URGENT

L'Oréal

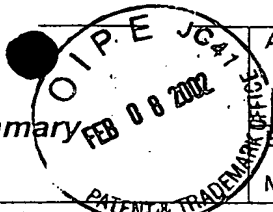
XHS

| | |
|--|-------------------------------|
| BURNS, DOANE, SWECKER & MATHIS, L.L.P. RECEIVED | |
| <i>C</i> <i>1/25</i> | JAN 25 2002 <i>1/25/02</i> |
| DOCKETED | |

Response due 2/10/02

JAN 24 02
JAN 24 02

Office Action Summary



Application No.

09/927,488

Examiner

Marina Lamm

Applicant(s)

CANDAU, DIDIER

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 1-31 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Election of species should be required prior to a search on the merits in all applications containing both species claims and generic or Markush claims. (MPEP 808.01(a))
2. Claims 1-4 are generic to a plurality of disclosed patentably distinct species comprising:
 - (a) benzotriazole compounds encompassed by formula (I) and
 - (b) bisresorcinyltriazine compounds encompassed by formula (II);which mixture requires a burdensome classification, and/or bibliographic, manual and computer search.

Accordingly, the Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, i.e. a single compound, from each component (a) and (b) to form a composition, even though this requirement is traversed. Applicant should include a chemical structure of the elected compounds if not already contained in the specification. An election of "compounds of formula X" will be considered non-responsive. An example of the proper response would be a topical sunscreen composition comprising 2-(2'-hydroxy-5'-methylphenyl)benzotriazole as a compound (a) and 2,4-bis{[4-(2-ethylhexyloxy)-2-hydroxy]phenyl}-6-(4-methoxyphenyl)-1,3,5-triazine as a compound (b).

To be complete, a response to the election of species requirement should include a proper election along with a listing of all claims readable thereon, including any claims subsequently added. MPEP 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species

Art Unit: 1616

to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541. The examiner can normally be reached on Monday to Friday from 9 to 5.

The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

ml

12/6/01


JOSE G. DEES
SUPERVISORY PATENT EXAMINER
1616

Attachment for PTO-948 (Rev. 03/01, or earlier)

6/18/01

The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.

INFORMATION ON HOW TO EFFECT DRAWING CHANGES

1. Correction of Informalities -- 37 CFR 1.85

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTOL-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made, other than correction of informalities, unless the examiner has approved the proposed changes.

Timing of Corrections

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.

06/01/01

EXHIBIT 2

Copy of Envelope for
Office Communication

IC 2900

CM1

Bldg./Room

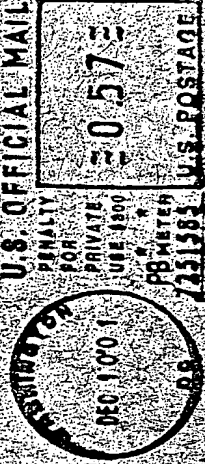
Organization

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231

IF UNDELIVERABLE RETURN IN TEN DAYS

OFFICIAL BUSINESS

AN EQUAL OPPORTUNITY EMPLOYER



TEST AVAILABLE COPY